

### **REMARKS**

Upon entry of this amendment, Claims 2-14, 16-18, 21, 22, 24-37, and 39-58 constitute the pending claims in the present application. Claims 1, 15, 20, and 38 are cancelled without prejudice by this amendment. Applicants reserve the right to pursue claims of identical or similar scope in future continuation or divisional applications.

New claims 56-58 are added. Support can be found throughout the specification, *see*, for example, page 5, first and third paragraphs; and page 7, third paragraph. No new matter is introduced.

As a result, some existing claims previously depending on the cancelled independent claims have been amended to depend on other claims, including the new independent claims.

Applicants respectfully request reconsideration in view of the following remarks. Issues raised by the Examiner will be addressed below in the order they appear in the Office Action.

*Rejection of Claims 1, 2, 12, 14, 15, 18, 20, 22, 25, 27, 28, 31, 32, 36, 37, 40, 41, and 44-46 Under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Pat. No. 5,591,139 (Lin et al., first cited in IDS filed on January 21, 2000)*

The Examiner maintains the rejection under 35 U.S.C. § 102(b) in view of Lin for the reason of record. In response to Applicants' argument advanced in the previous response, the Examiner argues that "[c]laim analysis involves a comparison of the claimed structure with the disclosed structure of the prior art, not a comparison of the choice of terms used by Applicant and the prior art to described their respective inventions."

Although not acquiescing in the reasoning of the Office Action, Applicants have cancelled independent Claims 1, 15, and 20, added new independent claims 56-58, and amended the dependent claims to depend on the allowed or new independent claims. Applicants submit that the new independent claims are novel and non-obvious over the cited art, either alone or in combination (even assuming having motivation to combine), since no cited art teaches or suggests a porous microneedle, a microneedle comprising a polymer, or a substrate and/or microneedle made from flexible materials.

Therefore, Applicants submit that all pending claims are novel and non-obvious over the cited art. Reconsideration and withdrawal of the rejections are respectfully requested.

Rejection of Claims 1-4, 6, 7, 10, 15, 27, 29-34, 36, and 40 Under 35 U.S.C. § 103(a) as being obvious over JP 7-132119 (Yoshihiko, first cited in IDS filed on January 21, 2000) in view of Lin (supra)

The Examiner argues that Yoshihiko teaches all the limitations of the claimed invention, except that the length of the microneedles being between 500  $\mu$ m and 1 mm, while Lin allegedly cures the defect.

Because of the above claim amendment, Applicants submit that the combined teaching still fails to teach or suggest all the limitations of the claimed invention, even assuming (without agreeing, and for the sake of argument) that there is motivation to combine Yoshihiko and Lin.

Thus, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Rejection of Claims 1, 2, 11, 14-17, 19-21, 23, 24, 27, 28, 30-32, 35-37, 40, 41, and 44-46 Under 35 U.S.C. 103(a) as being obvious over U.S. Pat. No. 5,801,057 (Smart et al., first cited in IDS filed on January 21, 2000) in view of Lin (supra)

The Examiner argues that Smart teaches all the limitations of the claimed invention, except that the length of the microneedles being between 500  $\mu$ m and 1 mm, while Lin allegedly cures the defect.

Because of the above claim amendment, Applicants submit that the combined teaching still fails to teach or suggest all the limitations of the claimed invention, even assuming (without agreeing and for the sake of argument) that there is motivation to combine Smart and Lin.

Thus reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are respectfully requested.

Double Patenting

The Office Action objects Claims 8, 9, 13 and 26 for allegedly being a substantial duplicate of Claim 53.

Due to the claim amendments, this objection is rendered moot. Reconsideration and withdrawal of the objection are respectfully requested.

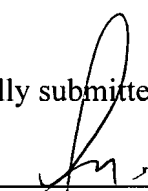
### CONCLUSION

In view of the foregoing amendments and remarks, Applicants submit that all pending claims are in condition for allowance. Early and favorable reconsideration is respectfully solicited. The Examiner may address any questions raised by this submission to the undersigned at 617-951-7000. Should an extension of time be required, Applicants hereby petition for same and request that the extension fee and any other fee required for timely consideration of this submission be charged to **Deposit Account No. 18-1945**, under Order No. **BVTP-P01-539**.

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Respectfully submitted,

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